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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,570	01/14/2000	Gary L. Swoboda	TI-28933	8552

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EXAMINER

PHAN, THAI Q

ART UNIT PAPER NUMBER

2123

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/483,570

Applicant(s)  
Gary L. Swoboda

Examiner  
Thai Phan

Art Unit  
2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 14, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

This Office Action is response to patent application S/N: 09/483,570, filed on January 14, 2000. Claims 1-4 are pending in this official action.

#### ***Specification***

1. The disclosure is objected to because of the following informalities:

The attempt to incorporate subject matter into this application by reference to co-assigned patent applications without corresponding Serial Numbers to the related patent applications. Applicant is required to provide current serial number of the co-assigned patent application.

#### ***Drawings***

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 recites the limitation "said monitor privilege input" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Deao et al., patent no. 6,055,649.

As per claim 1, Deao anticipates method of in-circuit emulation of an integrated circuit with feature limitation very identical to the claimed invention (Abstract and Summary of the Invention). According to Deao, the in-circuit emulation method includes steps of detecting predetermined debug events for debug mechanism (col. 25, lines 27-46, cols. 42-43, for example), upon detection of debug stage or event suspending program execution except for at least one type interrupt, and executing an emulation monitor program via the at least one type of interrupt as claimed (cols. 45, 46, 50-54, for example).

As per claim 2, Deao discloses serial scan path, and assigning selective emulation resource to serial scan path of the monitor program (cols. 55-61, for instance).

As per claim 3, Deao discloses resource sharing including prioritizing resources, privilege resources, etc. for optimizing the performance.

As per claim 4, Deao discloses read and write scan registers, and assigning such registers to emulate circuit operation as claimed.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

1. Patent no. 3,891,974, issued to Coulter et al., June 1975
2. Patent no. 5,274,831, issued to Katsuta, Hiroshi, on Dec. 1993
3. Patent no. 5,511,217, issued to Nakajima et al., Apr. 1996
4. Patent no. 5,884,023, issued to Swoboda et al., on Mar. 1999
5. Patent no. 6,075,941, issued to Itoh et al., June 2000
5. Patent no. 6,289,300 B1, issued to Brannick et al., Sept. 2001
6. Patent no. 6,385,742 B1, issued to Kirsch et al., May 2002
7. Patent no. 6,446,221 B1, issued to Jaggar et al., on Sept. 2002
8. Patent no. 6,085,336, issued to Swoboda et al., on July 2000

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Phan whose telephone number is (703) 305-3812.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for formal communications intended for entry)


**Or:**

(703) 746-7240 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

September 19, 2002



KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER